

REMARKS

Claims 74-102 are pending in the application, with claims 74, 75 and 90 being independent. Claims 74, 75, 90, 98 are amended to better claim the invention by clarifying or rephrasing existing limitations, and is not intended as a narrowing amendment. Claim 76 is amended to claim other subject matter with support found at least at page 10, lines 11-14. Claim 101 is amended to better clarify the claimed subject matter. Claims 82, 83 and 85 are amended for grammatical or syntax reasons and are not narrowing amendments. New claim 102 is added for further consideration and includes subject matter from original claim 74. Reconsideration of the application is respectfully requested in view of the amendments and following remarks.

Traversal of §102(b) Rejection

Claims 75-90 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,014,688 to Venkatraman *et al* ("Venkatraman"). Applicant notes that the Examiner specified claims 75-90 in the rejection summary on page 4, but includes claims 93, 94, 96-100 also, on the following pages [at 6]. This rejection is respectfully traversed.

For anticipation of a claim under 35 U.S.C. § 102, a single prior art reference must contain each and every limitation of the claim, either expressly or under the doctrine of inherency. *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1570 (Fed. Circ), *cert. denied*, 488 U.S. 892 (1988). Applicants submit that Venkatraman does not disclose or suggest every limitation of the claimed inventions.

On page 2 of the Office Action, the Examiner states, in reference to the previous response by Applicant that "applicant alleges nowhere in Venkatraman that suggests of one or more successive computers than the first computer." However, the Examiner has misinterpreted Applicant's remarks. Claim 75 requires more than this. Claim 75 recites, in part:

...the notification information is collected by executing the executable instructions when triggered by an event at one or more successive computers other than the first computer.

On both page 2 and page 4 of the Office Action, the Examiner cites col. 8, lines 24-42 of Venkatraman to support his assertion that Venkatraman discloses these limitations of claim 75. When claim 75 is properly interpreted, neither this passage nor any other passage of Venkatraman discloses the limitations of claim 75. The passage at col.8, lines 24-42 merely discloses that return receipts may be returned to sender's own e-mail address, the address of another or the address of many others. However, this passage does not fulfill the requirements recited by claim 75. Claim 75 requires, in part, that the notification information is collected by executing the executable instructions when triggered by an event at one or more successive computers other than the first computer. This clearly does not occur anywhere in Venkatraman.

As to independent claim 90, the Examiner alleges that Venkatraman discloses all the limitations of claim 90 and cites Venkatraman, col. 8, lines 1-42, among other citations (at page 6 of the Office Action). However, claim 90 recites, in part:

*receiving electronic data having at least in part
computer executable instructions from a sending computer;
transmitting the received electronic data and
executable instructions to one or more successive
computers; and
wherein the computer executable instructions are
executed at the one or more successive computers and upon
transmission of an authorized user identifier to a network
address other than a network address of the sending
computer, access is granted to at least a portion of the
electronic data.*

But, Venkatraman does not disclose all these limitations. For example, Venkatraman fails to disclose “transmitting the received electronic data and executable instructions to one or more successive computers” (Emphasis added). Applicant points out that the term “successive” has a specific meaning which includes “consecutive,” for example. Applicant submits that the returned receipt operation described at the cited passage of Venkatraman does not fulfill these requirements. Moreover, Venkatraman also fails to disclose “wherein the computer executable instructions are executed at the one or more successive computers.”

For at least these reasons, Applicant submits that none of the prior art of record discloses all the limitations of claims 75 and 90.

Applicant also submits that many of the dependent claims are also allowable based on their own merits. For example, claim 100 recites, in part, the step of receiving an access granting message at the one or more successive computers. The Examiner cites col. 4, lines 61 to col. 5, line 2 for support of his rejection of claim 100. Applicant submits that Venkatraman does not disclose this limitation at this or any other passage. This passage has no reference at all to an access granting message, nor does Venkatraman disclose anywhere “receiving an access granting message at the one or more successive computers.”

Therefore, the 35 U.S.C. 102(b) rejection should be withdrawn and that independent claims 75 and 90, and those claims depending therefrom, are allowable.

Traversal of 103(a) Rejections

Claims 74 and 101 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Venkatraman in view of U.S. Patent No. 6,327,610 to Uchida et al. (“Uchida”). Claims 77-78, 91, 92 and 95 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Venkatraman in view of U.S. Patent No. 6,075,862 to Yoshida et al. (“Yoshida”). These rejections are respectfully traversed.

In order to reject a claim under 35 U.S.C. §103(a), MPEP 2143 mandates that three basic criteria must be met.

First, there must be some suggestion or motivation, either in the reference themselves or in knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claimed limitations.

Applicant submits that there is no reasonable expectation of success and the references, when combined, do not teach all the limitations of claim 74.

Claim 74 recites in part:

collecting notification information from a recipient of electronic content in response to an attempt to access the electronic content;

initiating transmission of the collected notification information to an address other than that of an immediate sender of the electronic content; and

selectively controlling access to the electronic content based on a result of the transmission of the notification information.

On page 8 of the Office Action, the Examiner relies on Uchida to supply a missing feature of Venkatraman, namely selectively controlling access to the electronic content based on a result of the transmission of the notification information. However, when combining the disclosures of Uchida with Venkatraman, one cannot produce the invention of claim 74.

Uchida is directed to a broadcast system for distributing electronic mail to enable prevention of enormous traffic at a network caused by distribution of electronic mail (Summary). Uchida discloses a mail server 100, a sending terminal 240 for sending email, and accepting stations 250 (see Fig. 1). The mail server 100 has an input/output interface 110, an input unit 120 and an output unit 130 for sending and receiving email to and from network 231 a storage unit 140 for storing email, a command processing unit 160 for controlling operations (col. 6, lines 54-60 and Fig. 2).

With reference to Fig. 3, when the sending terminal 240 generates email to be broadcast-distributed, the sending station 240 produces an access code related to the main body of the email in question (col. 7, lines 25-30). When a distribution destination of the email is registered at the mail server 100 in advance, the sending terminal 240 selects destination code as a transmission destination of the email. If a distribution destination is not registered, then a distribution list is generated by the sending terminal 240 (col. 7, lines 29-38). The sending station then sends a set of mail data that includes a main body of electronic mail, title, an access code, transmission destination data, and a transmission command to the mail server 100 (col. 8, lines 38-41).

At the mail server 100, the input/output interface 100 receives mail data from the network 111 (step 400 in Fig. 4). The mail data is transferred to the input unit 120 under

control of the control unit 160. The input unit searches the mail data for a command for broadcast distribution and extracts and provides the command to the command processing unit 150 (col. 8, lines 56-65). The main body of the email is stored in the main body storage unit 142, the title is stored in the title storage unit 142, an access code stored in the access code storage unit 143 and the destination data in the transmission destination address storage unit 144 (col. 8, lines 1-8).

The output unit 150 sends the title and access code to every accepting station 250 of every receiver indicated by the destination data (col. 8, lines 9-16). A receiving station may then choose to receive the main body of the email or not (col. 8, lines 42-51). For receiving email, the accepting station 250 sends back a request containing the access code for the email main body. The mail server then sends back the email main body (col. 8, lines 55-62) to complete processing. In Uchida, an accepting station (“receiver”) either receives the email or does not receive the email, and only when the receiver receives the email (i.e., electronic content) does the receiver become a “recipient” of the electronic content, otherwise the receiver is not yet a “recipient.”

However, the language of claim 74 has certain requirements among the elements of the claim that cannot be achieved when employing the combination of Uchida with Venkatraman. Uchida controls access to the “electronic content” (i.e., email main body) by either delivering the “electronic content” (i.e., email main body) or not (see col. 8, lines 42-61), perhaps using an access code. But the language of claim 74 requires certain relationships which cannot be met by combining the invention of Uchida with Venkatraman.

Claim 74 requires, in part: “*collecting notification information from a recipient of electronic content...*,” “*initiating transmission of the collected notification information...*” and, “*selectively controlling access to the electronic content based on a result of the transmission of the notification information.*” Claim 74 recites certain relationships within the claim itself, which are necessary to bear in mind, as explained more fully below.

Now, according to the passage cited by the Examiner, col. 8, lines 42-61, Uchida can only provide the “electronic content” (i.e., email main body) by using a proper access code, or Uchida does not provide the “electronic content,” which according to the

Examiner constitutes selectively controlling access to the “electronic content” [Office Action page 8, at 8]. This is the only “control” to the email main body that Uchida describes and no other is disclosed. So in Uchida, access to the “electronic content” (i.e., email main body) is either all or none, and once the receiver receives the “electronic content,” the step of “selectively controlling access...” is done and complete. That is, once the receiver has the email main body, the receiver has unfettered access to the email (“electronic content”).

But, this is in stark contradiction to the requirements of claim 74, which controls access to the “electronic content” once there is already a recipient, which can only be true if the “electronic content” has been received, otherwise, there is no recipient. Note also, that it is the same “electronic content” throughout claim 74 and not different “electronic content.” But, since Uchida can only control access by controlling whether the “electronic content” (i.e., main email body) is provided to the receiving station or not, then Uchida can never succeed in providing the missing features of Venkatraman. Uchida necessarily creates a contradiction which conflicts with the language of claim 74, and therefore the combination of Uchida and Venkatraman cannot provide the features of claim 74.

As already stated, claim 74 clearly requires certain relationships. Claim 74 includes the steps of:

collecting notification information from a recipient of electronic content in response to an attempt to access the electronic content;

initiating transmission of the collected notification information to an address other than that of an immediate sender of the electronic content; and

selectively controlling access to the electronic content based on a result of the transmission of the notification information.

If the alleged “selectively controlling access” technique of Uchida is combined with Venkatraman as proposed by the Examiner, then the only “selectively controlling access

to electronic content” will be either a) the receiver (i.e., recipient) has the “electronic content,” or, b) the receiver does not have the “electronic content,” which in the case of b), the receiver is not yet a recipient. This is the only two possible cases disclosed by Uchida, and no other possibility exists. If the receiver does not have the “electronic content,” then the specific requirements and relationships of claim 74 cannot be fulfilled using Uchida’s technique since there is no “recipient of electronic content,” as required by claim 74. In this case, it then also follows that “collecting notification information from a recipient of electronic content” cannot be achieved. Further, “initiating transmission of the collected notification...” cannot be achieved, and lastly, “selectively controlling access to the electronic content based on a result of the transmission of the notification information” cannot be achieved.

If, on the other hand, when using Uchida’s technique with Venkatraman, the receiver does have, i.e., has received the “electronic content,” thereby establishing a “recipient,” then there can be no “selectively controlling access to the electronic content based on a result of the transmission of notification information” since the receiver already has gained unfettered access to the “electronic content,” which is contrary to the language of claim 74; or alternatively, renders this language of claim 74 meaningless, which cannot be a valid interpretation.

In Uchida, the only controlling access to the “electronic content” occurs prior to there being a “recipient” of the “electronic content.” Once a recipient of “electronic content” is established in Uchida, there can be no “selectively controlling access to the electronic content,” since the receiver already has unfettered access to the “electronic content.” The email delivery technique as disclosed by Uchida is inherently contrary to the requirements of claim 74. Therefore, Applicant submits that the combination of Venkatraman and Uchida cannot provide the invention of claim 74, as a reasonable person skilled in the art would conclude.

Claim 101 recites, in part:

initiating transmission of the electronic content from the computer collecting the notification information to one or more successive computers; and

receiving an access granting message at the one or more successive computers to selectively control access to the electronic information.

Applicants submit that neither Venkatraman nor Uchida, either singly or in combination, disclose or suggest all these features. Venkatraman, at the cited passage (col. 8, lines 24-42), is discussing return receipts which is not the same as the requirements of claim 101 which includes, for example, “initiating transmission of the electronic content from the computer collecting the notification information to one or more successive computers.” Further, neither reference discloses or suggests singly or in combination, “receiving an access granting message at the one or more successive computers to selectively control access to the electronic information.” (Emphasis added in both citations).

Applicants submit that the dependent claims 77-78, 91, 92 and 95 depend from a respective allowable independent claim 75 or 90 and therefore are also allowable for at least these reasons set forth above. Therefore, Applicants submit that all the 103(a) rejections should now be withdrawn.

Non-Statutory Double Patenting

Applicant acknowledges the double patenting rejection and respectfully requests that the requirement to file any terminal disclaimer be held in abeyance until allowable subject matter has been indicated.

Conclusion

In view of the foregoing amendments and remarks, Applicants submit that all of the pending claims are in clear condition for immediate allowance and respectfully requests that the application be passed promptly to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 23-1951.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Charles J. Gross", written in a cursive style.

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